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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,968	09/15/2000	Tyson Winarski, Esq.	110/103	3019

7590  
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PHOENIX, AZ 85018

EXAMINER
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VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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10/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/662,968	<b>Applicant(s)</b> WINARSKI, ESQ. ET AL.	
	<b>Examiner</b> NARESH VIG	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**Reopening of Prosecution After Appeal Brief or Reply Brief**

In view of the appeal brief filed on 08 August 2008, PROSECUTION IS HEREBY REOPENED. Correct Document Number of Hunter US Patent has been identified, and, Sparks et al. used in the previous office action has been identified, In addition, response to pending claims have been clarified in the office action as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

John Weiss.

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629

### **DETAILED ACTION**

This is in reference to communication received 20 December 2007 and 08 August 2008. Claims 11 – 16 and 18 are pending for examination.

#### ***Response to Arguments***

Applicant's arguments and concerns for amended claims which have been responded to in response to pending amended claims 11 – 16 and 18.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 – 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eller et al. US Patent 7,038,637 in view of Hunter, US Patent 6,424,998 and Sparks et al. US Patent 6,167,382.

Regarding claims 11, 13 – 16 and 18, Eller teaches an apparatus for a wireless electronic billboard commerce system. Eller teaches:

plurality of electronic billboards with:

a video display for showing a video stream [Eller, Fig. 2 and disclosure associated with Fig. 2]; Eller does not explicitly teach different types of video display devices. However, Hunter teaches different type of video display devices for displaying of image [Hunter, claim 5].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was adopted the idea of using different type of video display devices and modify Eller to have capability of providing billboard services in plurality of types of locations. For example, in store billboard may be LED display whereas, in a trade show the display device is a LCD device which is larger display but takes lesser space as compared to an LED device.

Eller in view of Hunter teaches:

a billboard computer adapted to process digital files to show on said video display as a video stream, said billboard computer is coupled to and controls said video display [Eller, Fig. 2 and disclosure associated with Fig. 2]; and

Eller in view of Hunter does not explicitly teach billboard antenna coupled to billboard computer for transferring video data to said billboard computer. However, Eller teaches ads can be uploaded to the billboard system through a direct connection locally, or remotely using landlines, cable, satellite signaling, fiber optic cable, wireless transmissions, etc. [Eller, Col. 2, lines 53 – 56]. **It is old and known to one of ordinary skill in the art that wireless communication requires an antenna to catch the signal** (see KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Eller in view of Hunter teachings have a billboard antenna coupled to said billboard computer to be able to catch the signal containing the data in a wireless communication environment as taught by Eller, combine prior art elements according to known methods to yield predictable results.

Eller in view of Hunter teaches capability wherein:

a local Ethernet coupled to a global computer network (using commercially available technology like Token-ring, Ethernet etc. to implement LAN to connect local devices is old and known to one of ordinary skill in the art). **Also, it is known to one of ordinary skill in the art the distributed network environment of a business wherein remote office are also sometimes identified as Small Office Home Office (aka SOHO) have computer systems interconnected in their premise using commercially available networking technology like Token-Ring, Ethernet etc. to make a Local Area Network (aka LAN), and, by using a router (manages local Ethernet) connect said LAN to the Central Office and other remote satellite office(s) using Wide Area Network using commercially available solutions like IBM SNA, High Speed Internet, DSL, Wireless Networks like VSAT, DirecPC etc. In addition, applying modern electronics to older systems has been commonplace in recent years (Leapfrog Enterprises, Inc. v. Fischer Price, Inc., 485 F.3d 1157, 82 USPQ2d 1687; Fed. Cir. 2007)**

Eller in view of Hunter teaches concept wherein said local Ethernet can comprise:

- a main computer (e.g. router, bridge etc.) to manage said local Ethernet;
- a communication system to wirelessly communicate with the plurality of electronic billboards, wherein the communication system comprises:

- a communication server coupled to the main computer system for storing data to transmit; and

- a transmission antenna coupled to said communication server to transmit the data and receive transmitted data (as responded to earlier, in a wireless communication system, antenna is used for transmission of and receiving of the signals);

- a web server coupled to the main computer for hosting a website accessible from the global computer network;

- a database server coupled to the main computer, the database server comprising:

Even though, Eller does not explicitly recite a registration system to allow a party to become a registered user of said wireless electronic billboard commerce system. However, Eller implicitly teaches a registration system to allow a party to become a registered user of said wireless electronic billboard commerce system. Eller recites “certain pre-approved clients may be able to skip step 308 and upload their ad directly to the billboard system” [Eller, col. 3, lines 50 - 51]. This clearly teaches that Eller has the capability to identify advertisers who can upload their ad directly to the billboard

Art Unit: 3629

system. Also, Eller teaches clients can make purchases either through a set up account or by making payment at the time of purchase [Eller, Fig. 3, 306]. **Also, Using a known technique for using a log on to a system of a business is an old an known concept. For example, Amazon.com, BarnesAndNoble.com, Sears.com which allows only users who are registered to make purchase on their websites. Concept of applying a known technique to a known device or method ready for improvement to yield predictable result is obvious to one of ordinary skill in the art; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.** Sparks teaches system and method wherein a user can design a production of advertising over the internet. Sparks teaches concept of using a registration system [Sparks, Fig. 3, 4 and disclosure associated with the Figure].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Eller in view of Hunter by adopting teachings of Sparks to be able to control access to the system, combine prior art elements according to known methods to yield predictable results.

In addition, even though, Eller in view of Hunter does not teach an ad creation system coupled to login system for allowing register user to create new video advertisements said wireless electronic billboard commerce system to display on at least one of said plurality of electronic billboards (i.e. not created at user workstation). However, Eller in view of Hunter teaches the idea wherein client downloads add



Art Unit: 3629

creation software from the system for creating new video advertisements to display on at least one of said plurality of electronic billboards [Eller, Fig. 3 and disclosure associated with Fig. 3]; Sparks teaches that a remote user can create ad on the system (i.e. created on the system by a remote user) [Sparks, col. 5, line 42 – col. 6, line 47].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Eller in view of Hunter by adopting teachings of Sparks and allowing users to create ad on the system to implement license control by minimizing user downloading ad creating software from the system, combine prior art elements according to known methods to yield predictable results.

Eller in view of Hunter and Sparks teaches concept of:

a registration system to allow a party to become a registered user of said wireless electronic billboard commerce system [Eller, Fig. 3 and disclosure associated with Fig. 3];

login system coupled to the registration system to allow registered users access to said wireless electronic billboard commerce system, wherein the login system will send a security alert to the main computer when a login ID and password are invalid multiple times within a predefined time frame to freeze an associated account. Freezing of an account upon multiple predefined times to secure the system is old and known to one of ordinary skill in the art at the time of invention (see *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007)) [Eller, Fig. 3 and disclosure associated with Fig. 3];

an account system coupled to said login system to allow the registered user to view and update financial activity, billboard purchases, contact information, and billing information [Eller, Fig. 3, and disclosure associated with the figure];

an ad creation system coupled to the login system for allowing said register user to create new video advertisements within said wireless electronic billboard commerce system to display on at least one of said plurality of electronic billboards [Sparks]

an access purchase system that provides a table of billboard information, said table of billboard information includes a listing of available locations, a listing of available time periods, and a listing of prices, said access purchase system searches a database to determine if said electronic billboard is available to display said advertisement at a requested location and a requested time [Eller, Fig. 3 and disclosure associated with Fig. 3];

a video advertisement stored as a digital file in the database server, said digital file is uploaded to said main computer through said global computer network, said main computer transfers said digital file to said communication system, said communication system transmits said digital file as a signal, said billboard antenna receives said signal, said billboard computer processes said signal, said billboard computer shows said signal on said video display as a video stream [Eller, Fig. 3 and disclosure associated with Fig. 3],

web-site accessible on said global computer network.

upload database, access purchase system provides an upload code for said digital file when said advertisement is purchased, determine if upload code is acceptable, transfer digital file to communications system when upload code is verified. (Eller teaches concept wherein a user uploads advertising content which will be displayed at the advertiser's selected billboard(s) at the time purchased by the advertiser [Eller, Fig. 3, 309]. **This clearly teaches that Eller teaches some kind of storage means to be able to download advertiser uploaded advertisement content to the selected billboard at the time selected by the advertiser).**

Regarding claim 12, as responded to earlier, Eller in view of Hunter and Sparks teaches satellite for receiving digital file from said communication server and transmits said digital file to said billboard antenna (Eller teaches using satellite communication for transmission of advertisement to remote billboard).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. IBM Communications Server for Windows NT
2. Wave Wireless Networking to Exhibit Wireless Connectivity Products At Networld

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 25, 2008

/Naresh Vig/  
Primary Examiner,  
Art Unit 3629